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APPLICANT: Donald R. Van Der Moere EXAMINER: Ernesto Garcia
APPL. NO.: 10/802,984 GROUP ART UNIT: 3679
FILED: March 17, 2004 ATTY DKT NO.: D5270
TITLE: COATED PISTON PIN

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G. Boller

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Mail Stop Appeal Brief - Patents
Commissioner for Patents
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REPLY BRIEF

Dear Sir:

This paper comprises a timely reply to an Examiner's Answer dated June 21, 2007 and will continue to reference the issues on appeal by the same designation used in Section VII (Argument) of the Appeal Brief.

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VII. A. - Rejection of Claims 8 and 10-14 under 35 U.S.C. 112, second paragraph.

In view of the Answer's withdrawal of the rejection of Claims 8 and 10-14 under 35 U.S.C. 112, second paragraph, it is unnecessary for the Board to consider the Appeal Brief's argument on this issue.

VII. B. - Rejection of Claims 1, 3, 4, 6, and 7 under 35 U.S.C. 102(b) In view of Kumuro.

Line 1 on Page 10 of the Answer incorrectly quotes the Appeal Brief argument. (Has the word "pin" been omitted after the word "piston"?)

That said, Page 10, lines 8-9 of the Answer, and the accompanying Fig.3 copied on that Page from the reference, identify for the first time by a specific reference numeral (13) the particular element that the Examiner considers to correspond to the subject matter of these claims, namely a "piston pin", such as shown in Fig. 4 of the present application also copied onto that Page immediately to the left of Kumuro Fig. 3.

The Board is asked to notice that the Examiner describes the correspondence between those Figures in this way: "The examiner disagrees since claim 1 is directed to the pin 10 as shown in appellant's Figure 4, which is similar to feature 13 shown in Comoro et al."

It is earnestly submitted that "similarity" is not equivalent to "identity" that is needed to support rejection under 35 USC 102(b).

The subject matter of Kumuro relates to piston rings, not piston pins, or wrist pins. What Kumuro describes as "test piece" 13 would, it is submitted, be understood by one of ordinary skill as nothing more than a convenient medium for testing the effectiveness of the piston ring coating, and in no way as a piston pin, or wrist pin. That this understanding is correct is confirmed by the obvious difference in relative proportions of the Kumuro test piece 13 and Appellant's piston pin 10. Even with the recognition that patent drawings are typically understood not to be "to scale" engineering drawings, it is submitted that one of ordinary skill looking at test piece 13 would have no reason to consider it a wrist pin because it is simply too short in relation to its diameter to function as a wrist pin.

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Appellant submits that the Examiner's Response to Argument shows that the Appeal Brief Argument, namely that Kumuro does not teach a piston pin, as claimed in claims 1, 3, 4, 6, and 7, is indeed correct.

Reversal of this rejection is respectfully requested.

VII. C. - Rejection of Claim 5 under 35 U.S.C. 103(b) as anticipated by Komuro.

The last sentence on Page 4 of the Answer doesn't address the concern expressed in the Appeal Brief about the confused statutory basis for rejection. In fact, that last sentence (as paraphrased in the above heading) is ambiguous because, as understood, it confuses a rejection under 35 USC 103 with one under 35 USC 102.

Appellant respectfully requests withdrawal of this rejection for reasons presented in the Appeal Brief, and further in view of Section VII. B. of this Reply Brief.

VII. D. - Rejection of Claims 8, 10, and 15 under 35 U.S.C. 103(a) as unpatentable over McKone in view of Kochendorfer.

The Answer, in reference to Fig. 6 of McKone, has chosen to continue to ignore McKone's own description of that Figure which, as pointed out in the Appeal Brief, states that FIG. 6 shows "the usual piston 1 having therewith a wrist pin 17 to which is connected in the usual manner a connecting rod 18" [page 4, lines 86-88] and goes on to explain that "[t]he end of the connecting rod bearing on the wrist pin has the usual cylindrical bearing thereon" [page 4, lines 89-91].

The "usual cylindrical bearing" would, it is submitted, be understood by one of ordinary skill as a separate part, sometimes also called a bushing. Even if no such separate part is immediately apparent in Fig. 6, the Examiner has provided no valid technical reason to support the inference that McKone positively teaches a piston-wrist pin-connecting rod combination lacking such a bushing or bearing, an inference that is contradicted by McKone's explicit statement that the usual cylindrical bearing is present. Indeed, it is submitted that one of ordinary skill familiar with materials typically used in the various components of such a combination would perceive the necessity of a separate bushing or bearing.

Appellant continues to rely on the argument presented in the Appeal Brief, as re-emphasized here, and respectfully requests reversal of this rejection.

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VII. E. - Rejection of Claims 10-12 and 17-19 under 35 U.S.C. 103(a) as unpatentable over McKone, in view of Kochendorfer, and further in view of Komuro.

Appellant continues to rely on the argument presented in the Appeal Brief, as re-emphasized above in Section VII. D. with respect to Claims from which Claims 10-12 and 17-19 depend, and respectfully requests reversal of this rejection.

VII. F. – Rejection of Claims 13 and 20 under 35 U.S.C. 103(a) as unpatentable over McKone, in view of Kochendorfer and Komuro, and further in view of Fukutome.

Appellant continues to rely on the argument presented in the Appeal Brief, as re-emphasized above in this paper with respect to Claims from which Claims 13 and 20 depend, and respectfully requests reversal of this rejection.

VII. G. – Rejection of Claims 14 and 21 under 35 U.S.C. 103(a) as unpatentable over McKone, in view of Kochendorfer, Komuro, and Fukutome, and further in view of Wakefield.

Appellant continues to rely on the argument presented in the Appeal Brief, as re-emphasized above with respect to Claims from which Claims 14 and 21 depend, and respectfully requests reversal of this rejection.

Respectfully submitted,

Date: August 21, 2007

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